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Jurgen Conrady

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06/03/2004

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EXAMINER

HARPER, HOLLY R

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,039

Applicant(s)

CONRADY, JURGEN

Examiner

Holly R. Harper

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2879

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 60 is/are allowed.
- 6) ☒ Claim(s) 31-42 and 53-59 is/are rejected.
- 7) ☒ Claim(s) 43-47, 50, 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

The Amendment, filed on 3/15/04, has been entered and acknowledged by the Examiner.

Claim 60 has been entered.

Claims 48, 49, and 52 have been canceled.

The drawings have been entered

The Specification has been amended.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 31-38, 40, and 53-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Haluska et al. (USPN 5,635,249).

In regard to claim 31, the Haluska reference discloses a luminescent film formed from a hydridosiloxane resin and phosphor particles (Column 2, Lines 25-44 and Lines 55-56).

The Examiner notes that the claim limitation of "wherein the film is produced by the following steps: (a) mixing a hydroxyl polydiorganosiloxane with an organohydrogen siloxane, (b) adding luminescent particles; and (c) generating a chemical reaction by

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means of a platinum catalyst at room temperature“ is drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 32, the Examiner notes that the claim limitation of “wherein the hydroxyl polydiorganosiloxane comprises various polymers with a minimum viscosity of 1000 centipoise at 25 degrees Celsius “ further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 33, the Examiner notes that the claim limitation of “wherein the hydroxyl polydiorganosiloxane is formed as at least one of hydroxyl polydimethylsiloxane, its copolymers, phenylmethylsiloxane and polymethyl-3, 3, 3-trifluoropropylsiloxane“ further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

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In regard to claim 34, the Examiner notes that the claim limitation of "wherein the organohydrogen siloxane is formed as silicone with at least two silicon-bonded hydrogen atoms per molecule" further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 35, the Examiner notes that the claim limitation of "wherein the organohydrogen siloxane comprises one of homopolymers, copolymers, and mixtures thereof" further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 36, the Examiner notes that the claim limitation of "wherein the platinum catalyst comprises one of a platinum chloride, platinum salts, and chloroplatinic acid" further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product

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and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 37, the Examiner notes that the claim limitation of "wherein the chloroplatinic acid is in the form of one of a hexahydrate and anhydrous chloroplatinic acid" further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 38, the Haluska reference discloses that the film is less than 500 microns thick (Column 4, Lines 16-19).

In regard to claim 40, the Haluska reference discloses that the particles are in the range of submicron to 10 microns (Column 4, Lines 21-24).

In regard to claims 53 and 55-57, the Haluska reference discloses a luminescent film formed from a hydridosiloxane resin and phosphor particles (Column 2, Lines 25-44 and Lines 55-56). A chemical reaction is generated by the addition of a platinum catalyst (Column 3, Lines 36-41).

In regard to claim 54, the Examiner notes that the claim limitation of "wherein the hydroxyl polydiorganosiloxane comprises various polymers with a minimum viscosity of 1000 centipoises at 25°C" further limits the recited process. Accordingly, it is necessarily drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a

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process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haluska et al. (USPN 5,635,249).

The limitations of claim 31 are met in the rejection by Haluska above.

In regard to claim 39, the Haluska discloses the claimed invention except for the limitation of the surface density of the particles. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to use particles with a surface density between 1 and 20 mg/cm<sup>2</sup>, since discovering an optimum value of a result variable is considered within the skills of the art.

5. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer et al. (USPN 5,051,653) in view of Haluska et al. (USPN 5,635,249).

In regard to claim 41, the DeBoer reference discloses a low-pressure discharge lamp with an enveloping body made of quartz (Column 11, Lines 41-44), which is UVC transparent, and electrodes which can be contacted from the outside projecting into the

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enveloping body (Figure 1). The DeBoer reference does not disclose the use of a fluorescent film with luminescent particles. The Haluska reference teaches that a hydridosioxane resin with phosphor particles is beneficial in the use of fluorescent lamps (Column 1, Lines 63-65) because the coating does not crack under stress or undergo significant shrinkage (Column 1, Lines 45-55). Thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to incorporate the fluorescent film to a fluorescent lamp, as taught by Haluska, because it is more durable.

The Examiner notes that the claim limitation of "wherein the film is produced by the following steps: (a) mixing a hydroxyl polydiorganosiloxane with an organohydrogen siloxane, (b) adding luminescent particles; and (c) generating a chemical reaction by means of a platinum catalyst at room temperature." is drawn to a process of manufacturing, which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of an unobvious difference between the claimed product and the prior art, the subject product-by-process claim limitation is not afforded patentable weight (see MPEP 2113).

In regard to claim 42, the Haluska reference discloses the use of a fluorescent film in fluorescent lamps, but does not disclose whether the coating is on the outside or the inside of the lamp envelope. However, it is well known in the art that coatings can be added to either the inner or outer surface of discharge lamps. Thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to incorporate the fluorescent film to an outer surface of the fluorescent lamp.



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6. Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haluska et al. (USPN 5,635,249) in view of Bilgrien et al. (USPN 6,677,407).

In regard to claims 58 and 59, the Haluska reference discloses the use of a platinum catalyst, but not the specific details about the catalyst. The Bilgrien reference teaches that a platinum catalyst can be chloroplatinic acid, either as hexahydrate form or anhydrous form. This type of a platinum catalyst is preferred because it is the most widely used and provides a favorable effect (Column 6, Lines 22-33). Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate a platinum catalyst of chloroplatinic acid, either as hexahydrate form or anhydrous form, as taught by Bilgrien, because it creates a favorable effect on the reaction and is widely used.

***Allowable Subject Matter***

7. Claim 60 is allowed.

Regarding claim 60, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 60, and specifically comprising the limitation that a fluorescent film that contains a silicone elastomer with luminescent particles is wrapped like a bandage around a body part of the patient and a discharge lamp transparent to UVC is used to expose the fluorescent film to radiation.

8. Claims 43-47, 50, 51, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Regarding claim 43, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 43, and specifically comprising the limitation of the fluorescent film having different doping applied to the envelope body.

Regarding claim 44, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 43, and specifically comprising the limitation of a displacement body arranged in the enveloping body so that channels are formed between the enveloping body and the displacement body.

Regarding claims 45-47, claims 45-47 are allowable for the reasons given in claim 44 because of their dependency status from claim 44.

Regarding claim 50, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 41, and specifically comprising the limitation of the film being fitted to the enveloping body in the form of an interchangeable frame.

Regarding claim 51, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 51, and specifically comprising the limitation that the irradiation arrangement includes a dispensing roller and a take-up roller on which the fluorescent film is wound up.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Harper whose telephone number is (571) 272-2453.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-2457. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Joseph Williams*  
*Joseph Williams*

*HH*

Holly Harper  
Patent Examiner  
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